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PTO/SB/21 (09-04)
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TRANSMITTAL FORM

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Total Number of Pages in This Submission	18

Application Number	10/758,820
Filing Date	01/16/2004
First Named Inventor	Joseph Lee Haughawout
Art Unit	2635
Examiner Name	Yang, Clara I.
Attorney Docket Number	81230.68US3

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
- ☑ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
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- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
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Firm Name	Customer No. 34018 - Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	December 6, 2005	Reg. No.	35,906

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Signature	Vivian DelaRosa		
Typed or printed name	Vivian DelaRosa	Date	December 6, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Haughawout et al.	Examiner:	Yang, Clara I.
Serial No.:	10/758,820	Art Unit:	2635
Filed:	January 16, 2004	Attny Doc.:	81230.68US3
Title:	System And Method For Using Appliance Power Awareness to Select A Remote Control Command Set		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-14, 29-40, 44, and 45 which rejection was set forth in the Office Action mailed July 29, 2005. A timely Notice of Appeal was filed.

This brief is accompanied by the fee required by 37 CFR § 41.20

This Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 6th day of December, 2005.

By: Vivian DelaRosa
Vivian DelaRosa

I. Real Party In Interest

The real party in interest is Universal Electronics Inc.

II. Related Appeals And Interferences

It is not believed that any appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 1-14, 29-40, 44, and 45 remain pending and, having been finally rejected, are the subject of this appeal. Claims 15-28 and 41-43 were canceled during the course of prosecution.

The Section IX appendix provides a clean, double spaced copy of pending claims 1-14, 29-40, 44, and 45.

IV. Status Of Amendments

The claims are in condition for appeal – no amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

The claimed subject matter is generally directed to a system for setting up a controlling device to command operations of an appliance.

With reference to Figs. 1 and 15 and Paras. 0062+ of the subject application for patent (U.S. 2004/0169590), a user may indicate a desire to setup the controlling device, e.g., remote control 10, by the user actuating a setup key 310 of the controlling device 10. Once the controlling device 10 enters the setup mode, the controlling device 10 transmits one or more commands selected from command code sets stored within the memory of the controlling device

10 to an appliance for the purpose of attempting to cause a change in the power state in the appliance. A power monitoring unit 14 is provided to monitor the appliance to determine if the appliance responds to a transmitted command by changing its power state. To sense a change in the power state of the appliance the power monitoring unit 14 may monitor current drawn by the appliance. When the power monitoring unit 14 senses that the appliance has changed its power state in response to a command transmitted from the controlling device 10, the power monitoring unit 14 will reported the change in power state back to the controlling device 10 by means of a transmission of data to the controlling device 10. In response to the receipt of a transmission from the power monitoring unit 14, the controlling device 10 will automatically set itself up to control operations of the appliance by selecting as the command code set for remotely controlling operations of the appliance the command code set that included the transmitted command that caused the appliance to respond with the change in its power state that was discerned by the power monitor 14.

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection under 35 U.S.C. § 103 of the claims can be maintained when the rejection of the claims fails to demonstrate where the prior art suggests modifying the primary reference to arrive at the invention claimed.

VII. Argument

A) Status of the claims

In the application claims 1-14, 29-40, 44, and 45 remain pending. No claims presently stand allowed.

B) Summary of the rejection of the claims

The claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Kamon (U.S. 5,726,645) as modified by Ivie (U.S. 5,815,086).

In rejecting the claims, it was asserted that Kamon teaches a remote control system comprising operation detection circuitry 10 wherein the operation detection circuitry determines the current power state of the appliance and includes a transmission portion for transmitting information to the remote control where the remote control responds to the information transmitted from the operation detection circuitry 10 to select a set of command codes to use to command operations of an appliance.

Despite the assertion in the rejection of the claims that the operation detection circuitry 10 of Kamon determines the current power state of an appliance, it was later acknowledged in the rejection of the claims that the operation detection circuitry 10 of Kamon fails to monitor either the power supplied to the appliance or current flow to the appliance as claimed instead disclosing operation detection circuitry 10 which monitors nothing more than a signal output by the headphone jack of the appliance.

Owing to this deficiency in Kamon, the rejection of the claims then set forth that Ivie teaches a transmitter for an appliance which has a current monitor for monitoring power supplied to the appliance.

The rejection of the claims thus concluded that it would have been obvious to modify the operation detection circuitry of Kamon as taught by Ivie to thereby enable the "headphone plug 10a of Kamon's appliance 20 to be free for its intended purpose instead of being used as a power monitor."

C) Applicable Law

It is well settled that a determination of obviousness requires that a combination of prior art references disclose a claimed invention "as a whole," i.e., each and every element considering each and every word. This requirement that the claimed invention be considered "as a whole" is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the invention claimed. Thus, to assure that such "hindsight reasoning" is not used when assessing the patentability of a claimed invention, a rejection based upon a combination of references requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, confronted with the same problems and with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

D) Remarks Addressing The Rejection Of The Claims

It is respectfully submitted that the rejection under 35 U.S.C. § 103 reflects the impermissible use of the specification of the applicant as a template to combine the parts of the references cited for the purpose of deprecating the invention claimed. More particularly, it is respectfully submitted that the rejection of the claims reflects the impermissible use of "hindsight reasoning" since it has not been demonstration that an artisan of ordinary skill in the art at the

time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references cited and combined them in the claimed manner. Rather, the rejection appears to be impermissibly relying upon the mere fact that references can be combined or modified which it is well established does not render the resultant combination *prima facie* obvious unless the prior art also suggests the desirability of the combination.

As discussed above, it has been acknowledged in the rejection of the claims that Kamon fails to disclose, teach, or suggest the desirability of monitoring the power supplied to an appliance or current flow to an appliance for use in connection with automatically setting up a remote control as is set forth in the claims under consideration.

It is respectfully submitted that Ivie likewise fails to disclose, teach, or suggest the desirability of monitoring the power supplied to an appliance or current flow to an appliance for use in connection with automatically setting up a remote control. In this regard, while Ivie does disclose a power monitor wherein the power monitor has an associated IR transmitter where the IR transmitter is used to transmit commands directly to an appliance, nothing within Ivie suggests using the power monitor to monitor power supplied to an appliance to cause the IR transmitter to transmit a signal to a controlling device which indicates to a controlling device that a transmitted command code caused a change in a current power state of the appliance to thereby cause a configuration of the controlling device as is claimed. Rather, Ivie only discloses, teaches, and suggests monitoring power supplied to an appliance to determine if the IR transmitter should proceed with the transmitting of a power toggle command to an appliance when commanded to do so. (Col. 7, lines 8-20). Thus, when Ivie is considered in its entirety, it is evident that the power monitor of Ivie, which only functions to transmit a power toggle command to an appliance when commanded to do so and when appropriate given the current

power state of the appliance, simply fails to disclose, teach, or suggest the desirability of generating a signal which indicates a change in the current power state of an appliance for any purpose, let alone for the purpose of configuring a remote control. In Ivie, a change in the current power state of the appliance simply fails to result in the power monitor taking any action in response to such change. Thus, absent the disclosure of at least this aspect of the invention claimed, which inventive aspect is also acknowledged to be missing from Kamon, it is respectfully submitted that the limited teachings of Ivie cannot be said to suggest the desirability of modifying the Kamon system to arrive at the invention that is set forth in the claims under consideration.

It is similarly noted that, when Ivie is considered it its entirety, nowhere does Ivie disclose, teach, or suggest the desirability of modifying Kamon to thereby enable the headphone plug of Kamon's appliance to be free for its intended use instead of being used as a power monitor which is the rationale for the modification espoused in the rejection of the claims. While Ivie not only fails to suggest the desirability of modifying Kamon to enable the hadphone plug of Kamon's appliance to be free for its intended use, Ivie also fails to disclose, teach, or suggest the desirability of modifying Kamon to thereby overcome the multiple disadvantages that are associated with the Kamon system which disadvantages are, however, overcome by the invention that is set forth in the claims under consideration. These disadvantages include, for example, the fact that the Kamon system cannot be utilized to select a command code set for an appliance that does not generate an audio output, that the Kamon system will not function in the case where the appliance is inadvertently muted, and that the Kamon system will not function in the case where the appliance is not receiving an audio/video input which is required for the appliance to generate an audio output. Thus, when Ivie is fully and fairly considered in its

entirety, nothing from Ivie can be said to suggest any reason for modifying Kamon to arrive at the invention that is set forth in the claims under consideration.

From the foregoing, it is respectfully submitted that it has been demonstrated that Ivie not only fails to disclose, teach, or suggest that which has been acknowledged to be missing from Kamon but also fails to include any teaching that might be said to evidence that it would have been obvious or even desirable to modify Kamon for any purpose, let alone for the purpose espoused in the rejection of the claims, to thereby arrive at the invention that is set forth in the claims under consideration. Accordingly, it is submitted that the determination of obviousness set forth in the rejection of the claims, which relies upon a motivation to modify Kamon that finds no basis in any cited reference, clearly reflects the impermissible use of hindsight reasoning. It is for at least this reason that it is respectfully submitted that the express teachings of Ivie cannot support a *prima facie* case of obviousness and the rejection of the claims must be withdrawn.

It is additionally respectfully submitted that, even if one of ordinary skill in the art were motivated to modify Kamon for the purpose of enabling the headphone plug of Kamon's appliance to be free for its intended use instead of being used as a power monitor, the express teachings of Ivie would suggest meeting this objective in a manner that is not in keeping with the manner asserted in the rejection of the claims. In this regard, when Ivie is considered in its entirety *as required*, the express teachings of Ivie suggest that the headphone jack of Kamon's appliance may be rendered free not by modifying the power monitor of Kamon but instead by removing the Kamon power monitor from the headphone jack and modifying the remote control of Kamon whereupon the remote control of Kamon remains configurable by a user entering a number on the keypad to select which set of infrared codes from a library of infrared codes will

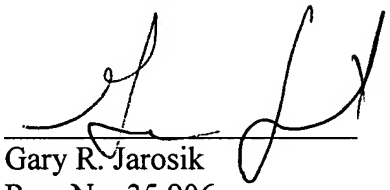
apply. (*See* Ivie; col. 8, lines 34-52). Thus, it will be appreciated that modifying Kamon in the only manner that is in keeping with both the express teachings of Ivie and the espoused modification objective would not lead one of ordinary skill in the art to the invention claimed. For this additional reason it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the rejection of the claims should be withdrawn.

E) Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: December 6, 2005

By: 

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VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

1. A system for setting up a control device to command the operations of an appliance, comprising:

a power monitor associated with the appliance, the power monitor having circuitry for monitoring power supplied to the appliance to thereby determine a current power state of the appliance and a first wireless communication module; and

the control device having a library of command code sets, a second wireless communication module for transmitting a command code selected from a command code set to the appliance, and a third wireless communication module for receiving a communication from the first wireless communication module of the power monitor;

wherein the control device has setup mode programming for transmitting to the appliance via the second wireless communication module a command code from one of the command code sets and for receiving from the power monitor via the third wireless communication module a signal which indicates that the transmitted command code caused a change in the current power state of the appliance whereupon the command code set which includes the command code to which the appliance responded by changing power states is selected for use in commanding the operations of the appliance.

2. The system as recited in claim 1, wherein the signal further comprises data indicative of an address of the power monitor.

3. The system as recited in claim 1, wherein the command code is a command code that directly

affects a power state of the appliance.

4. The system as recited in claim 1, wherein the command code is a command code that indirectly affects a power state of the appliance.

5. The system as recited in claim 1, wherein the control device is adapted to automatically transmit a command code from each of a plurality of command code sets until receiving the signal from the power monitor.

6. The system as recited in claim 5, wherein each of the plurality of command code sets are used to command operations of one type of appliance.

7. The system as recited in claim 6, wherein the type of appliance is user-designated.

8. The system as recited in claim 5, wherein the command code from each of the plurality of command code sets is transmitted in an order reflective of an install base of the one type of appliance.

9. The system as recited in claim 1, wherein the control device is adapted to respond to a manual interaction to transmit a command code from each of a plurality of command code sets until receiving the signal from the power monitor.

10. The system as recited in claim 9, wherein each of the plurality of command code sets are

used to command operations of one type of appliance.

11. The system as recited in claim 10, wherein the type of appliance is user-designated.

12. The system as recited in claim 9, wherein the command code from each of the plurality of command code sets is transmitted in an order reflective of an install base of the one type of appliance.

13. The system as recited in claim 1, wherein the first communication module and the third communication module each comprise an RF communication module.

14. The system as recited in claim 1, wherein the second communication module comprises an IR communication module.

15-28. (Canceled)

29. A system for setting up a control device to command the operations of an appliance, comprising:

a power monitor associated with the appliance, the power monitor having circuitry for monitoring power supplied to the appliance to thereby determine a current power state of the appliance and a first wireless communication module; and

the control device having a library of command code sets and at least a second wireless communication module for transmitting data indicative of a command code selected from a

command code set corresponding to the appliance, wherein the control device has setup mode programming for transmitting data indicative of a command code from one of the command code sets via the second wireless communication module and for receiving from the power monitor via the second wireless communication module a signal which indicates that the transmitted command code caused a change in the current power state of the appliance whereupon the command code set which includes the command code to which the appliance responded by changing power states is selected for use in commanding the operations of the appliance.

30. The system as recited in claim 29, wherein the signal further comprises data indicative of an address of the power monitor.

31. The system as recited in claim 29, wherein the command code is a command code that directly affects a power state of the appliance.

32. The system as recited in claim 29, wherein the command code is a command code that indirectly affects a power state of the appliance.

33. The system as recited in claim 29, wherein the control device is adapted to automatically transmit a command code from each of a plurality of command code sets until receiving the signal from the power monitor.

34. The system as recited in claim 33, wherein each of the plurality of command code sets are used to command operations of one type of appliance.

35. The system as recited in claim 34, wherein the type of appliance is user-designated.

36. The system as recited in claim 33, wherein the command code from each of the plurality of command code sets is transmitted in an order reflective of an install base of the one type of appliance.

37. The system as recited in claim 1, wherein the control device is adapted to respond to a manual interaction to transmit a command code from each of a plurality of command code sets until receiving the signal from the power monitor.

38. The system as recited in claim 37, wherein each of the plurality of command code sets are used to command operations of one type of appliance.

39. The system as recited in claim 38, wherein the type of appliance is user-designated.

40. The system as recited in claim 37, wherein the command code from each of the plurality of command code sets is transmitted in an order reflective of an install base of the one type of appliance.

41-43 (Canceled)

44. The system as recited in claim 1, wherein the power monitor monitors current flow to the appliance.

45. The system as recited in claim 29, wherein the power monitor monitors current flow to the appliance.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.